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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,808

09/08/2003

Geoffrey B. Rhoads

P0880

1809

23735 7590 11/23/2010
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EXAMINER

CHEN, SHIN HON

ART UNIT

PAPER NUMBER

2431

MAIL DATE

DELIVERY MODE

11/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/658,808	Applicant(s) RHOADS, GEOFFREY B.	
	Examiner SHIN-HON CHEN	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40, 42, 43 and 46-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40, 42, 43 and 46-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-40, 42, 43 and 46-59 have been examined.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications, Application No. 09/476,686; 60/134,782; 09/343,104; 09/314,648; 60/134,782; 10/306,768; 09/292,569; 09/186,962; 08/649,419; 60/082,228; 09/186,962; 08/694,419; 08/637,531, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior-filed applications do not explicitly disclose comparing title signal to player signal for watermark embedded data.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-40, 42, 43 and 46-59 are rejected under 35 U.S.C. 102(a) as being anticipated by Cox et al. U.S. Pat. No. 6456725 (hereinafter Cox).

5. As per claim 1, Cox discloses a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in a player device, the method comprising:

downloading the digital data having the title signal via an Internet connection, wherein the title signal is carried with digital watermarking encoded in the digital data in which the digital watermarking is carried in the digital data through alterations to data representing the digital data (Cox: column 2 lines 18-20 and column 2 lines 32-35);

transferring the downloaded digital data to the player device (Cox: column 2 lines 19-20) ;

detecting, at the player device, the title signal in the digital data, the player device comprises a multi-purpose electronic processor configured as a detector, and said act of detecting utilizes the detector (Cox: column 2 lines 20-21);

comparing the title signal to the player signal (Cox: column 2 lines 21-22); and

performing an action based upon the comparison (Cox: column 2 lines 23-24).

6. As per claim 2, Cox discloses the method of claim 1. Cox further discloses wherein the digital data is streaming audio or video data (Cox: column 9 claim 2).

7. As per claim 4, Cox discloses the method of claim 1. Cox further discloses wherein the player signal is indicative of an attribute of the device, device user, data, or data owner (Cox: column 9 claim 3).

8. As per claim 4, Cox discloses the method of claim 1. Cox further discloses decoding the digital watermarking to obtain the title signal (Cox: column 9 claim 4).

9. As per claim 5, Cox discloses the method of claim 4. Cox further discloses wherein the digital watermarking contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal (Cox: column 9 claim 5).

10. As per claim 6, Cox discloses the method of claim 1. Cox further discloses wherein the action is performed if the title signal matches the player signal (Cox: column 9 claim 8).

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11. As per claim 7, Cox discloses the method of claim 6. Cox further discloses wherein the action is to inform the device user of the match and at least one consequence thereof (Cox: column 9 claim 9).

12. As per claim 8, Cox discloses the method of claim 7. Cox further discloses wherein the consequence is informing the user of the winning of a prize (Cox: column 9 claim 10).

13. As per claim 9, Cox discloses the method of claim 7, Cox further discloses wherein the digital data is digital video data (Cox: column 9 claim 11).

14. As per claim 10, Cox discloses the method of claim 7, wherein the digital data comprises digital audio data (Cox: column 9 claim 12).

15. As per claim 11, Cox discloses the method of claim 7. Cox further discloses wherein the action is to inform the device user of the match and of the player signal (Cox: column 9 claim 9).

16. As per claim 12, Cox discloses the method of claim 3. Cox further discloses wherein the player signal is indicative of a device number (Cox: column 9 claim 16).

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17. As per claim 13, Cox discloses the method of claim 1. Cox further discloses in which the title signal is encoded with the digital watermarking in a time varying manner (Cox: column 9 claim 17).

18. As per claim 14, Cox discloses the method of claim 3. Cox further discloses comprising inputting the player signal to the player device prior to the act of comparing (Cox: column 10 claim 18).

19. As per claim 15, Cox discloses the method of claim 6. Cox further discloses wherein perfect matching between the title signal and player signal is necessary in order to perform the action (Cox: column 10 claim 19).

20. As per claim 16, Cox discloses the method of claim 6. Cox further discloses wherein imperfect or approximate matching between the title signal and player signal is permitted in order to perform the action (Cox: column 10 claim 20).

21. As per claim 17, Cox discloses the method of claim 6. Cox further discloses wherein the title signal and player signal contain at least two fields, each field comprising a group of bits, wherein matching of fields between the title signal and player signal is permitted in order to perform the action (Cox: column 10 claim 21).

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22. As per claim 18, Cox discloses the method of claim 1. Cox further discloses wherein at least one title signal which when compared to the player signal evokes the performance of the action (Cox: column 10 claim 22).

23. As per claim 19, Cox discloses the method of claim 1. Cox further discloses wherein at least one title signal which when compared to the player signal evokes the performance of the action, is chosen to match at least one targeted demographic group (Cox: column 10 claim 23).

24. As per claim 20, Cox discloses the method of claim 1. Cox further discloses wherein the action is performed if the title signal matches the player signal and the action is to inform the device user of the match (Cox: column 10 claim 25).

25. As per claim 21, Cox discloses the method of claim 1. Cox further discloses wherein the player device comprises a personal computer and the act of transferring comprises storing the downloaded data to a recordable medium readable by the player device (Cox: column 10 claim 27).

26. As per claim 22, Cox discloses the method of claim 21. Cox further discloses wherein the acts of detecting, comparing and performing are performed after the act of storing is completed (Cox: column 10 claim 28).

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27. As per claim 23, Cox discloses the method of claim 21. Cox further discloses wherein the acts of detecting, comparing and performing are performed after the downloaded digital data is partially stored such that the title signal is available for use in the method before the act of storing is completed (Cox: column 10 claim 29).

28. As per claim 24, Cox discloses the method of claim 1. Cox further discloses wherein the player device is a personal computer and at least the act of detecting is performed in real time as the digital data is downloaded (Cox: column 10 claim 30).

29. As per claim 25, Cox discloses a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the digital data having the title signal (Cox: column 11 claim 31);

detecting, at the personal computing device, the title signal in the data, the personal computing device comprises a configured multi-purpose electronic processor, and said act of detecting utilizes the configured multi-purpose electronic processor (Cox: column 11 claim 31);

comparing the title signal to the player signal (Cox: column 11 claim 31); and

performing an action based upon the comparison, in which the player signal expires after a predetermined time such that it is no longer useful for comparison to the title signal (Cox: column 12 claim 53).

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30. As per claim 26-38, claims 26-38 encompass the same scope as claims 1-24.

Therefore, claims 26-38 are rejected based on the same reason set forth above in rejecting claims 1-24.

31. As per claim 39. (Currently Amended) A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

- providing the computer readable set of instructions having the title signal, in which the computer readable set of instructions represents an application program executable by the personal computing device;

- detecting the title signal in the computer readable set of instructions, in which the personal computing device comprises a software operating system for launching the application program, and wherein the act of detecting is performed by the software operating system operating on a multi-purpose electronic processor;

- comparing the title signal to the player signal; and

- performing an action based upon the comparison (Cox: column 11 claims 38 and 50).

32. As per claim 40, Cox discloses the method of claim 39. Cox further discloses wherein the operating system also performs the acts of comparing and performing (Cox: column 11 claim 51).

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33. As per claim 42, Cox discloses the method of claim 25. Cox further discloses further comprising updating the player signal for comparison to the title signal (Cox: column 12 claim 54).

34. As per claim 43 and 46-59, claims 43 and 46-59 encompass the same scope as claim 1-40, 42. Therefore, claim 43 and 46-59 are rejected based on the same reason set forth above in rejecting claims 1-40 and 42.

Claim Rejections - 35 USC § 102

35. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

36. As per claim 1-40, 42, 43, and 46-59, Cox discloses the claimed invention in U.S. Patent 6,456,725. Present application discloses claims that are identical or nearly identical to the prior patent, which was issued almost one year before filing of present application. Also, the terms used by present application are different from the Specification.

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Response to Arguments

37. Applicant's arguments with respect to claims 1-40, 42, 43 and 46-59 have been considered but are moot in view of the new ground(s) of rejection.

38. Applicant's arguments, see Appeal Brief, filed 6/22/10, with respect to the rejection(s) of claim(s) 1-40, 42, 43 and 46-59 under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Cox et al. U.S. Pat. No. 6,456,725.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIN-HON CHEN whose telephone number is (571)272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shin-Hon Chen
Primary Examiner
Art Unit 2431

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Primary Examiner, Art Unit 2431